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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,120	09/19/2003	Mehrdad Nikoonahad	TNCR.001US4	8430
7590 03/22/2004			EXAMINER	
James S. Hsue Parsons Hsue & de Runtz LLP Suite 1800 655 Montgomery Street San Francisco, CA 94111			ROSENBERGER, RICHARD A	
			ART UNIT	PAPER NUMBER
			2877	

DATE MAILED: 03/22/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/666,120

Applicant(s)

NIKOONAHAD ET AL.

Examiner

Richard A Rosenberg

Art Unit

2877

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 53-69 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) 53-69 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 2/13/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

Art Unit: 2877

1. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 53-69 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over what is claimed in U.S. Patent No. 6,633,302. Although the conflicting claims are not identical, they are not patentably distinct from each other because what is claimed in this application is also claimed, with somewhat different scope, in the patent. In particular, the use of an acousto-optic scanner is claimed in claim 1 of the patent, and the use of more than two detectors is claimed in claim 19 of the patent.

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 53-69 are rejected under 35 U.S.C. 102(b) as being anticipated by Nikoonahad et al (US 5,883,710).

The specification of the reference appears to be identical to the specification of this application; thus anything disclosed and properly claimed in this application is necessarily disclosed in the reference.

This application was filed as a continuation of earlier application 09/760,558; see the transmittal letter for this application. No other continuity claims were made there. The declaration and specification set forth this application as being a continuation in part of earlier application 08/351,664, giving no other continuity claims. However, earlier application 09/760,558 was not copending with the earlier application 08/351,664, thus the filing date of 08/31,664 has not been properly claimed in this application as no proper chain of copendency has been claimed. The effective filing date of this application is thus the date of 09/760,558, or 16 January 2001. Thus Nikoonahad et al , US 5,883,710, applied above, with a issue date of 16 March 1999, is available under 35 USC 102(b).

It is noted that there appears to be a chain of copendency available that could be claimed back to 08/351,664, which, if done, would obviate this rejection. However, the claims for continuity must actually be made, and they have not been made in this application at this time.

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 53-69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayano et al in view of Batchelder et al (US 4,740,708).

Hayano et al shows that it is known in the art to use more than two detectors arranged about a circumference of the surface being tested; see figure 14 of that reference. The detectors of Hayano et al are away from a normal of the surface, and positioned symmetrically in the azimuth. Those in the art could position the detectors according to the particular surfaces and types of flaws to be detected at hand in a particular application.

It is known in the art the deflector can comprise an acoustic-optic deflector. In an arrangement similar to that of Hayano et al in which a light beam is scanned across a moving object, Batchelder uses a scanner that comprises an acousto-optic deflector (84). It would have been obvious to use the scanning means comprising an acousto-optic deflector as taught by Batchelder in the device of Hayano et al because the basic scanning arrangement is the same, a light beam that moves in one direction and means to move the surface in the other, and so the advantage of the acousto-optic detector taught by Batchelder is equally applicable to the device of Hayano et al.

6. Hagiwara et al (US 5,149,982) and Hagiwara et al (US 5,363,187) show known inspection arrangements with more than two detectors arranged around the circumference of the surface being inspected.

Heebner et al (US 4,441,124) shows an inspection scanning system which comprises an acousto-optic deflector (42). Crabb et al (US 4,650,333) shows an inspection system with an acousto-optic deflector (104) as a scanning means; see column 7, lines 51-55.


7. The two Japanese references on the information disclosure statement filed 13 February 2004 that have been lined through were not considered because copies were not available in the file and not otherwise readily available.

8. Papers related to this application may be submitted to Group 2800 by facsimile transmission. The faxing of such papers must conform to the notice published in the Official Gazette, 1096 OG 30 (15 November 1989). The fax number is (703) 872-9306

Any inquiry concerning this communication or earlier communications from the examiner should be directed to R. A. Rosenberger whose telephone number is (571) 272-2428.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0956.

R. A. Rosenberger
11 March 2004



Richard A. Rosenberger
Primary Examiner